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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,527	09/30/2005	Udo Merker	100717-677-WCG	6199
27386 7590 12/18/2009 GERSTENZANG, WILLIAM C. NORRIS MCLAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER NGUYEN, KHANH TUAN				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,527

Applicant(s)

MERKER ET AL.

Examiner

KHANH T. NGUYEN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 38-75 is/are pending in the application.
- 4a) Of the above claim(s) 15-35 and 38-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Final

1. Claims 1-14 are currently pending in the instant application. Claims 15-35 and 38-75 have been previously withdrawn from further consideration. Claims 36-37 have been previously cancelled.
2. This application contains claims 15-35 and 38-75 drawn to an invention nonelected with traverse in the reply filed on 04/10/2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Status

3. The rejection of claims 1-6 and 8-14 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Pat. 4,697,001 (Walker) is **withdrawn** in view of applicant's remark filed on 09/11/2009 at pages 2-7.
4. The rejection of 10 claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over either Pub. 2002/0077450 A1 (Kirchmeyer)

or U.S. Pat. 7,112,368 B2 (Hsu) in view of U.S. Pat. 5,886,046 (Nishiyama) **stand rejected**.

Response to Arguments

5. Applicant's arguments filed on 09/11/2009 have been fully considered but they are not persuasive.

In response to the Applicant's remark on pages 7-10, Applicant argues that neither Kirchmeyer nor Hsu in combination with Nishiyama suggest a process for preparing the oxidant before said oxidant is brought into contact with precursors for said preparation of said conductive polymers. The examiner respectfully disagrees with the Applicant argument.

Initially, it should be noted that the amended claim 1 as filed on 03/13/2009 recites a "[P]rocess for preparing an oxidant for the preparation of conductive polymers, wherein a metal salt of an organic acid or an inorganic acid having organic radicals is treated with an ion exchanger to prepare said metal salt as an oxidant before said metal salt is brought into contact with precursors as an oxidant for said preparation of said conductive polymers."

It should be further noted that the amended limitation above does not further limit the process of preparing an oxidant, rather the amended limitation is drawn towards a method

of preparing conductive polymer. Thus, the amended limitation, i.e. the metal salt is brought into contact with precursors as an oxidant for said preparation of said conductive polymers, is not given patentable weight and is construed as intended use.

Consequently, claim 1 is interpreted as a process for preparing an oxidant wherein an organic acid metal salt or inorganic acid metal salt having organic radicals is treated with an ion exchanger.

At pages 5-6 of the previous Office action, Kirchmeyer is cited for suggesting a process for preparing an oxidant for the preparation of conductive polymers, wherein the inorganic acid metal salt such as iron(III) toluenesulfonate salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals [0032- 0035] is treated with a weak anion exchanger such as Lewatit® MP 62 [0048] to remove metal ions [0041] in the presence of organic solvents such as methanol, ethanol and butanol [0037]. Likewise, Hsu is recited for disclosing a process for preparing an oxidant for the preparation of conductive polymers by oxidative polymerization, wherein a metal salt of an organic acid or an inorganic acid containing one or more sulfonic acid radicals (e.g. iron(III) p-toluenesulfonate salt) (Col. 3, lines 23-37) is treated with an anion exchanger (e.g. Lewatit® MP 62) to quench the polymerization and remove

metal ions (Col. 3, lines 56- 60 and Col. 8, lines 40-41) in the presence of water or organic polar or non-polar solvents (Col. 4, lines 62-65). Both Kirchmeyer and Hsu are considered to suggest a process for preparing an oxidant wherein an organic acid metal salt or inorganic acid metal salt having organic radicals is treated with an ion exchanger.

While Kirchmeyer and Hsu are combined with Nishiyama to show that iron (III)-containing oxidant may be used in preparation of conductive polymer (See previous Office action pages 6-7), it is not necessary that the prior art suggest the oxidant is prepared before it is brought into contact with precursors for said preparation of said conductive polymers as argued for the reasons set forth above.

Based on the above rational, it is believed that the claimed limitations are met by the reference submitted and therefore, the rejection is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH T. NGUYEN whose telephone number is (571) 272-8082. The examiner can normally be reached on Monday-Friday 7:00-4:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Kopec/
Primary Examiner, Art Unit
1796

/KTN/
Examiner
12/14/09